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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,008	01/25/2002	Hiroshi Takemoto	07541.0002	8118

7590 07/08/2003

Finnegan Henderson Farabow  
Garrett & Dunner  
1300 I Street N W  
Washington, DC 20005-3315

EXAMINER

STOCKTON, LAURA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/048,008

Applicant(s)

TAKEMOTO ET AL.

Examiner

Laura L. Stockton, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-76 is/are pending in the application.
- 4a) Of the above claim(s) 34-55, 68 and 69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 56-67 and 70-76 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

Claims 34-76 are pending in the application.

### *Election/Restrictions*

Applicants' election with traverse of Group III in Paper No. 7 is acknowledged. The traversal is on the ground(s) that: (1) the PCT rules have been applied too narrowly; (2) the restriction has been required within Markush groups notwithstanding their common structural elements; (3) the Markush group elements of  $Y^2$  share a common structural element of having at least one  $-NR^G$  group; (4) the Markush group elements for  $Z^2$  share the common structural element of being an optionally substituted 5-6 membered ring group having at least two double bonds within the ring; (5) the restriction should be broadened to at least include a larger number of species for any or all of groups  $X^2$ ,  $Y^2$ ,  $Z^2$  and  $A^2$  since there are common structural elements within these groups; and (6) it would be a burden on the public to have a large

number of separate patents covering different sub-genera of Formula (I) and Formula (II).

All of Applicants' arguments have been considered but have not been found persuasive. The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The special technical feature in the compounds of Formula (I) and Formula (II) is a carbon. A carbon does not define a contribution over the prior art. Everything else in Formula (I) and Formula (II) are variables. Variables are not considered when determining the special technical feature. The special technical feature must be present in all compounds (e.g., a phenyl ring not a 5-6 membered ring group having at least two double bonds within the ring). Therefore, Applicants' arguments concerning Markush groupings within variables themselves (e.g.,  $Y^2$  and  $Z^2$ ) are not persuasive. The lack of unity groupings will not be expanded because it would

impose an undue burden on the Examiner and the Patent Office's resources since separate search considerations are involved.

The requirement is still deemed proper and is therefore made  
FINAL.

Subject matter not embraced by elected Group III and claims 34-55, 68 and 69 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

It is suggested that in order to advance prosecution, the non-elected subject matter be cancelled when responding to this Office Action.

### *Claim Objections*

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are cancelled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 62 (first occurrence in Preliminary Amendment A filed August 9, 2002) has been renumbered claim 61.

*Oath/Declaration*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the number of the Japanese priority document is incorrect in the Declaration.

*Specification*

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

*Allowable Subject Matter*

Claims 56-67 and 70-76 are objected to for containing non-elected subject matter. Claims presented drawn solely toward the elected invention of Group III would appear allowable over the art of record.

The elected invention of Group III is allowable over the art of record because the closest prior art of record {U.S. Pat. 5,330,998} fails to teach or suggest the instant claimed  $\text{-NR}^G\text{CO}(\text{CH}_2)_{0-2}$  group (represented by the instant  $\text{Y}^2$  variable) which links the instant  $\text{X}^2$  variable (which represents a thiazole ring) with the instant  $\text{Z}^2$  variable (which represents a phenylene ring). In U.S. Pat. 5,330,998, the link between the thiazole ring (X is S and Y is N) and the phenylene ring (V is  $\text{-CH=CH-}$ ) is a  $\text{-CH}_2\text{NR}^1\text{CO}$  group (n is 1 and W is  $\text{NR}^1\text{CO}$ ). Therefore, the elected invention of Group III is allowable.

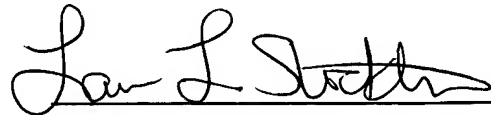
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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The fax phone number for the organization where this application  
or proceeding is assigned is (703) 308-4556.

A handwritten signature in cursive script, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

July 3, 2003